REMARKS

Applicant has carefully considered the Final Office Action of November 16, 2005 and offers the following remarks in response thereto.

Claims 1, 15, 16, 19-22, and 58 were rejected under 35 U.S.C. § 103 as being unpatentable over Lee et al. (hereinafter "Lee") in view of Terahara et al. (hereinafter "Terahara"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove that there is a suggestion to combine the references. To prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant previously argued that the Patent Office had not provided the required evidence to support the motivation to combine the references. The Patent Office responds in the current Office Action by repeating its original motivation to combining the references and stating:

> . . .it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(Office Action of November 16, 2005, page 6, lines 1-6). Applicant notes that this case law is comparatively old and has been refined by the more recent decisions from the Federal Circuit. Specifically, in *Dembiczak*, the Federal Circuit acknowledged that there was a wide range of sources from which the motivation to combine references could come, but stated that the range of available sources did not diminish the requirement for actual evidence. *Dembiczak* at 999. In short, the Federal Circuit recognized that the temptation presented by hindsight was so great that to combat its subtle, but powerful lure, the Federal Circuit needed to impose an additional requirement on the Patent Office. That additional requirement is actual evidence. Thus, if the motivation comes from the knowledge of someone skilled in the art, the Patent Office may rely on that knowledge so long as the Patent Office can provide evidence to prove that the knowledge

was available. In the absence of the actual evidence, broad assertions that the combination is obvious are not proper.

To date the Patent Office has not presented any evidence to prove the motivation to combine the references. Rather, it appears that the motivation comes from Applicant's disclosure and is improper. Since the motivation to combine the references is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the claims are allowable.

Claims 2, 3, 23, and 24 were rejected under 35 U.S.C. § 103 as being unpatentable over Lee in view of Terahara and further in view of Taylor et al. (hereinafter "Taylor"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine Lee and Terahara. As explained above, the Patent Office has not provided the evidence required by the Federal Circuit to combine the references. Since the Patent Office has not provided this evidence, the underlying combination is improper, and the rejection is improper.

Applicant further traverses the rejection because, as argued in the previous response, the Patent Office has not provided any evidence to support the combination with Taylor. As explained above, the Patent Office must do more than make an assertion about the obviousness of the combination. Since the Patent Office has not provided actual evidence, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

In response to Applicant's previous arguments along these lines, the Patent Office cites *McLaughlin* again. However, *Dembiczak*'s requirements replace those set forth in *McLaughlin* and the Patent Office has not complied with the new requirements set forth by the Federal Circuit.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The Patent Office has not properly supported the motivation to combine the references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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